

## REMARKS

Claims 8-11 have been amended to address the 35 U.S.C § 112 rejections made by the Examiner in finally rejecting these claims in the Office Action mailed on 10/03/02.

In that Office Action, the Examiner rejected claims 8-11 under 35 U.S.C § 112 as being vague and indefinite. In particular, the Examiner asserted that the recitation of “may be conveyed to a viewer” in claim 9 was vague and indefinite. Applicants have removed this language from claim 9.

The Examiner also asserted that the recitation “arranged to convey information” in claims 8 and 11 was also vague and indefinite due to the use of the term “information.” In particular, the Examiner questioned what the applicants meant by “information.” Applicants note that it is well-settled patent law that language in a claim should be given its ordinary and plain meaning unless the patentee expressed a desire or intent to define a term in a different manner. The plain and ordinary meaning of the word “information” is the act of informing or communicating knowledge. See The American Heritage Dictionary of the English Language (4<sup>th</sup> Ed. 2000) (defining information as “the communication of knowledge”); see also Webster's Unabridged Dictionary (1913)(defining information as the act of communicating intelligence); see also, the Online Plain Text English Dictionary (defining information as “news, advice, or knowledge, communicated by others or obtained by personal study and investigation; intelligence; knowledge derived from reading, observation, or instruction”). Moreover, Applicants have, through out the specification, used the term information consistent with its dictionary meaning. See Specification at p.1, line 5.

Nevertheless, to advance prosecution, Applicants have amended claims 8-11 to make clear that the protrusions are arranged in any manner that acts to form a communication to a viewer. Applicants have also clarified claim 11 so that the communication comprises “instructional” information. This amendment removes any doubt that the information that they intended the protrusions to convey in original claims 8-11 is a communicative message, such as instruction on how a package containing the writing should be handled, information about what the package contains, etc. See specification at p. 1 at lines 5-8, p. 2 lines 1-5, p. 3, lines 9-11. Applicants respectfully assert that the plain and ordinary meaning of a “communication” is a technique for expressing ideas or information effectively. See e.g., Merriam Webster's Collegiate Dictionary (Deluxe Ed. 1998). And therefore the terms “visual communication” and/or “visually

communicative message” encompasses any symbols, characters, or pictures conveying an idea or meaning, but would, of course, exclude mere decorations.

That the phrase “visually communicative message” is broad and encompasses many different forms of writing, including symbols, characters, diagrams, etc. does not, however, render the claims vague and indefinite because one can reasonably distinguish between an arrangement of protrusions that communicates a message or idea from an arrangement that is purely artistic or fanciful and that does not communicate. U.S. intellectual property law is replete with examples that distinguish descriptive information from fanciful informational markings. Applicants by these statements, which are part of the file history of the present application and must be considered when construing the claiming in any patent issuing on the instant application, make clear that the claims are limited to writings that communicate concrete information to a viewer and do not encompass fanciful markings that serve other and more abstract purposes. Thus, since Applicants’ invention encompasses the discovery of a better way to communicate written information that is inscribed on a transparent sheet, Applicants are entitled to broadly claim their invention and need not limit it to any specific content contained in any such communication so long as the communication relays a message to a person viewing it.

Applicants also respectfully submit that the word “instructional” as used in claim 11 also has a well-established plain and ordinary meaning. See e.g., Webster’s Dictionary (1913 Ed.) Applicants have in their specification evidenced an intention to use instruction in a manner consistent with its ordinary meaning. See also Specification at p. 2., lines 1-3 (clarifying that the writing is used for instructional purposes by stating clearly that “figure 2 shows a photo of the rotatable lid of a pill dispenser, on which lid the prescribed rotation direction is indicated by marking made according the invention”).

In addition to addressing the Examiner’s concerns about vagueness and indefiniteness, Applicants have taken this opportunity to correct what some might consider to be an ambiguity in the preamble of the claims due to the use of the word “or”). See e.g., Landis on Mechanics of Patent Claim Drafting (4<sup>th</sup> Ed. 2000) §24. By this amendment applicants have changed the preamble to recite a “writing” rather than a “marking or writing.” Applicants respectfully submit that the term “writing” has a plain and ordinary meaning that encompasses any visible sign, symbol or character that communicates or is intended to communicate an idea to one viewing the writing. See Webster’s Dictionary (1913 Ed.)(defining a “writing” as “letter or characters that serve as

visible signs of ideas, words, or symbols” or a “means to communicate”). This plain and ordinary meaning is consistent with the way Applicants have used the term writing in the specification. See page 1, line 5 (“Packagings made from plastic materials often contain . . . writings which may indicate how the packaging should be handled to obtain access, information about its contents, etc.”). And the plain and ordinary meaning is consistent with the recitation in the claims that the protrusions be arranged to form a visually communicative message. Thus, by this amendment Applicants are clarifying that their invention – unlike any of the prior art cited by the Examiner – is directed toward a writing that conveys and communicates information to a viewer viewing the front side of the transparent sheet.

In the previous Office Action, the Examiner also finally rejected claims 8-11 under §102(b) in view of U.S. Patent No. 5,723,200 to Oshima et al. (the “’200 patent”). Applicants respectfully request withdrawal of this rejection in view of the following remarks.

Applicants’ invention, as presently claimed, requires that a writing be formed on a film having both a front side for viewing and a back side where protrusions are disposed. The front side or viewing side of the film is required to be smooth and lack depressions, protrusions, groove and the like. The backside, on the other hand, contains protrusions that form the writing be arranged in such a manner as to form a communication to a viewer. For example, Applicants have stated in the specification that the writing may be a communication containing information about the contents of a package (see p. 1, lines 5-8) or that the writing may be a communication that indicates how to use a device (see p. 2 description of Figure 2).

The ’200 patent discloses the exact opposite of the Applicants’ invention. First, the ’200 patent discloses a set of raised protrusions on the viewing side of the plastic film, not on the opposite side as is required by the pending claims. See Col. 3, lines 22- 31 (“Figure 1 shows a first embodiment of the present invention. This figure is an enlarged plan view showing a decorative sheet comprising a transparent sheet body 1 having a front surface 2 which is provided with a plurality of convex lens-shaped projections 21 along as an arbitrary continuous pattern axis . . . in a hexagonal pattern and a rear surface 3 which is provided dot figures 31 printed thereon”). It is clear from Figures 2-3 that the protrusions are viewed from the front side as the specification discussions that they are visible from a direction X and invisible from a direction Y and these directions X and Y are clearly shown as coming from the front side – i.e., the protrusion containing side – of the film. (See Col. 3, lines 42-50) Not only are X and Y shown as angles of incidents for viewing the strip

from the front side, the very term "front" connotes the viewing side. See Websters Revised Unabridged Dictionary (1913).

Second, the '200 patent does not disclose a writing formed by the protrusions on the back side of the film. Instead, it discloses the use of a **printing on the backside** of the film to create a **decorative pattern** that is selectively viewable or changeable when viewed from the front, protrusion containing surface. Nothing in the '200 patent disclosure suggests that **protrusions alone** that are **disposed on the non-viewing side** could be used to form a writing that communicates information to a viewer viewing the front side. In fact, it discloses explicitly that "in order to attain the aforementioned object of the present invention," i.e. to provide a **highly decorative sheeting** having a pattern which is changeable with the direction of observation (see '200 patent at Col. 1, lines, 34-38), a plurality of convex lens-shaped projection are provided on a **front surface** of a transparent sheet . . . while **figures are printed on a rear surface.**" See the '200 patent at Col. 1, lines 38-45. Thus, the '200 patent does not disclose that a writing can be formed from the protrusions alone. In contrast, the claimed invention requires that **the writing be formed by the protrusions on the non-viewing surface** and does not require the markings that make up the writing to be formed from a printing on the back side or non-viewing side.

Third, the '200 patent does not disclose a writing wherein the protrusion are arranged to form a visually communicative message, but merely discloses a highly decorative pattern that appears different as the viewing angle is change. The pattern is not, by definition, a writing since it does not communicate an idea or an instruction. And there is nothing in the '200 patent disclosure that suggests the protrusions on the front of the film could be moved to the back to form a communication to a viewer viewing the film from the front. As discussed above, U.S. intellectual property law, in numerous contexts, differentiates between markings that are informational or descriptive and markings that are fanciful or arbitrary. This distinction is relevant here because Applicants are only claiming the former and not the later. And nothing in the prior art suggests using protrusions on a rear side of a transparent sheet to communicate concrete and tangible information with a viewer viewing the front side of the sheet.

And finally, the '200 patent does not disclose that the front side should be smooth and lack protrusions and depressions. In all embodiments disclosed in the '200 patent the front or viewing side contains the protrusions that form a decorative pattern. Nowhere does the '200 patent suggest

or imply that an information conveying writing that conveys communicative information be formed by protrusions on the opposite side of a smooth film.

In fact, not only does the '200 patent disclosure not contain all the limitations inherent or explicitly required by the claimed invention, the '200 patent's own disclosure suggests that the pattern shown therein would not be useful for creating a writing which communicates information. One would not seek to use the disclosure of the '200 patent to create a communicative writing because any writing created in accordance with the teaching of the '200 patent would appear to change as the viewing angle changed; this would frustrate the general purpose of having a writing because rather than making the communication of an idea easier, it would make that communication dependent upon the angle that the writing is being viewed at.

In contrast to the '200 patent's disclosure, the Applicants' invention is a writing that, by definition, communicates an idea or instruction. And as presently claimed, the invention explicitly requires that the writing be a communication, which, by definition, is "an effective means of expressing an idea." As the Applicants' invention is inherently clearly visible regardless of the viewing angle or angle of incident of the light striking the writing, it is an effective way to communicate a message to a viewer. See Specification at p.2, lines 32-34 ("markings made according to the invention, i.e. as an array of uniform circular protrusions on the read side of a transparent member, are clearly almost luminous appearing, notwithstanding the angle of incidence of the light").

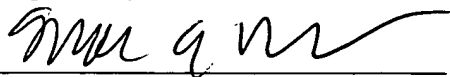
## **CONCLUSION**

Applicants respectfully submit that the present amendment presents no new issues or new matter. Applicants also submit that this amendment reduces issues should an appeal become necessary. However, Applicants believe strongly that in view of the amendment and accompanying remarks, the pending claims are in condition for allowance. Applicants therefore request reconsideration of the application in view of the above amendments and remarks and withdrawal of the rejections made final in the previous Office Action and allowance of the pending claims.

The Examiner should feel free to contact the applicants' Attorney by telephone if there are any questions concerning this amendment or application.

The commissioner is hereby authorized to charge any fee that may be due in connection with this paper or this application or to credit any overpayments to Deposit Account No. 14-1447.

Respectfully submitted,



Date: May 28, 2003

Marc A. Began Reg. No. 48,829  
Novo Nordisk Pharmaceuticals, Inc.  
100 College Road West  
Princeton NJ 08540  
(609) 919-7829



23650

PATENT TRADEMARK OFFICE

## VERSION WITH MARKINGS TO SHOW CHANGES MADE

8. A writing ~~or marking~~ on a transparent plastic member having a smooth front side surface that lacks protrusions or depressions and from which the marking is to be read and a rear side surface opposite the front side surface, wherein the writing or marking is formed by an array of protrusions having the shape of spherical segments ~~disposed~~ on the rear side surface and wherein the array of protrusions ~~is~~ are arranged to form a visually communicative message ~~convey information~~.
9. The writing ~~or marking~~ of claim 8, wherein the writing is visible ~~the information may be conveyed~~ to a viewer viewing the front surface of the plastic member.
10. The writing ~~or marking~~ of claim 8, wherein the protrusions have the shape of half spheres.
11. The writing ~~or marking~~ of claim 9, wherein the communicative message is comprised of instructional information ~~protrusions are arranged to convey information to a viewer viewing the front surface of the plastic member~~.